

## REMARKS

The Examiner has rejected Claims 1 and 3 through 15. Claim 1 has been amended to specify the structure and dimensions of the claimed invention of an infant heel warming device. Support for this amendment can be found throughout the specification and Figure 6, for example. No new matter has been introduced by way of the above amendment. Claims 1 and 3 through 15 are pending.

### **Rejections under 35 U.S.C. §102:**

Claims 1, 3, 5-8 and 11-15 have been rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Silver U.S. Patent No. 5,897,580. Applicant respectfully traverses this rejection for the following reasons.

The Examiner argues that Silver teaches Applicant's claimed invention. In order for a claim to be anticipated under 35 U.S.C. §102, a single prior art reference must disclose each and every element of the claimed invention. Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 715, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984). If the reference fails to suggest even one limitation of the claimed invention, the claim is not anticipated. Atlas Powder Co. v. E.I. du Pont De Nemours & Co., 750 F.2d 1569, 1574, 224 U.S.P.Q. 409,411 (Fed. Cir. 1984).

The Examiner has failed to present a single prior art reference that anticipates Applicant's claimed invention. Applicant has amended independent claim 1 to specify the structure and dimensions of the claimed device, i.e., that the device is structured and dimensioned to accommodate an infant's foot. Support for this amendment can be found throughout the specification as well as illustrated in Figure 6. Accordingly, the context of

Applicant's invention has been clarified.

The Examiner has again attempted to support a rejection under 35 U.S.C. §102 by citing a reference pertaining to what is clearly a *breast warming device*. Applicant has amended independent claim 1 to clarify the claimed invention to the Examiner. As the device of Silver is structured and dimensioned to accommodate and surround a human breast, it cannot be said to anticipate a claimed invention that is structured and dimensioned to accommodate an infant's foot. Applicant assumes that the anatomical differences between an adult breast and baby's foot are clearly understood.

The Examiner appears to be confused as to Applicant's claim language. Specifically, the Examiner has referred to claims 5 and 6 as being a "product-by-process" claim format. Applicant's claim 5 language "outer fabric layer is laminated onto said first skin-contacting side" and claim 6 language "outer fabric layer is adhered onto said first skin-contacting side..." is pointing out with particularity the structural interrelationship between two components (elements) of the claimed invention as part of what is clearly a product claim (see independent claim 1 from which claims 5 and 6 depend). Thus, the Examiner has misconstrued these claims as being product-by-process claims.

Claims 1, 3 and 5 through 8 and 11 through 15 are not anticipated by Silver within the proper meaning of 35 U.S.C. §102. This rejection should, therefore, be withdrawn.

**Rejections under 35 U.S.C. §103:**

Claims 1 and 4 have been rejected by the Examiner under 35 U.S.C. §103(a) as

being unpatentable over Cheney, III (U.S. Patent No. 5,143,048) in view of Silver U.S. Patent No. 5,897,580) and further in view of Manker U.S. Patent No. 5,800,492. Applicant respectfully traverses this rejection for the following reasons.

The Examiner argues that Cheney III teaches an infant heel warming device but fails to disclose a number of Applicant's claimed features including a flexible polymeric containment for thermochemical composition, transparent viewing side, and outer fabric layer on one side, as well as securing strap.

Indeed, Cheney III fails to teach or suggest numerous features of Applicant's claimed invention. The infant heel device of Cheney III is absent many of the advantageous structural features required by Applicant's claimed invention as acknowledged by the Examiner. It is not understood, however, why one of ordinary skill in the infant heel warming art would turn to features pertaining to a *breast* warming device and view such as modifications suitable for a device to be attached to an infant's foot. Again, Applicant's amendment to independent claim 1 now recites the structural context of the instant invention.

Manker is likewise absent teaching or suggestion of numerous features required by Applicant's claims. No teaching or suggestion is seen in the Manker reference as to the transparency/fabric structural combination of the instant invention. In other words, Manker does not address all of the problems solved by Applicant's invention, as the essence of Applicant's invention does not exclusively reside in a securing strap feature.

The shortcomings of the Silver reference have been discussed in the remarks against the rejection under 35 U.S.C. §102(b) and are likewise applicable here and repeated herein. Again, Silver relates to a device for placement on a breast, which does

not pertain to Applicant's invention.

None of these references alone or in combination would have lead one of ordinary skill in the art to arrive at Applicant's invention. This is especially the case as the combination of the two references cited by the Examiner that actually have to do with the context of the claimed invention, i.e., an infant heel warming device, still fail to present the combination of features required by Applicant's claims. Moreover, as the claims clearly pertain to an infant heel warming device as the relevant context of the invention, the amendment to clarify such having been suggested by the Examiner, one of ordinary skill in the art would not have turned to the breast device of Silver for features specifically improving the problems of conventional devices in the infant heel warming field. Accordingly, the motivation to combine these three references is not seen. The Examiner has thus failed to present a combination of teachings that fairly teach or suggest Applicant's invention as required to adequately support a proper rejection on obviousness grounds.

Given the above, the claimed invention is not unpatentable over the above references within the proper meaning of 35 U.S.C. §103. This rejection should, therefore, be withdrawn.

Claims 9 and 10 have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Silver U.S. Patent No. 5,897,580 and in view of Angelillo et al. U.S. Patent No. 5,736,110. Applicant respectfully traverses this rejection for the following reasons.

The shortcomings of the Silver reference have been discussed in the remarks

against the rejection under 35 U.S.C. §102(b) and are likewise applicable here and repeated herein. The Examiner relies upon Angelillo for a teaching of a thermochemical activator, or trigger, to initiate exothermic reaction.

Again, Applicant's invention does not pertain to breast devices. Further, the essence of Applicant's invention does not exclusively reside within a particular type of thermochemical activator. In combining Silver as a primary reference with Manker as is the basis of the Examiner's rejection, one of ordinary skill in the art would at best arrive at a breast warming device with a physical activator. This is insufficient to support the Examiner's allegation that such combination would have lead to Applicant's claimed invention, which pertains to an infant heel warming device – much less any of the advantageous features specifically required by the claims. No motivation is seen to modify a breast warming device of Silver into an infant heel warming device to begin with. The Examiner has thus failed to present a combination of teachings that fairly teach or suggest Applicant's invention as required to adequately support a proper rejection on obviousness grounds.

Given the above, the claimed invention is not unpatentable over the above references within the proper meaning of 35 U.S.C. 103. This rejection should, therefore, be withdrawn.

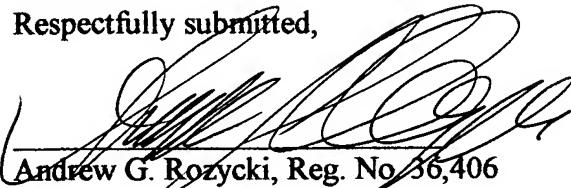
**Conclusion:**

In light of the above amendments and the accompanying remarks, it is believed that the application is now in condition for allowance, and prompt notification to that effect is earnestly solicited. The Examiner is invited to contact the undersigned to

discuss the application on the merits if it is believed that such discussion would expedite  
the prosecution.

Respectfully submitted,

Dated: April 20 2006

  
Andrew G. Rozicki, Reg. No. 36,406  
Attorney for Applicants  
Cardinal Health, Inc.  
7000 Cardinal Place  
Dublin, Ohio 43017  
Tel. (614) 757-7413  
Fax (614) 757-2243